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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHN S. HENDRICKS and MICHAEL S.
ASMUSSEN

Appeal 2011-011846
Application 09/237,827
Technology Center 2400

Before THOMAS S. HAHN, ERIC B. CHEN, and JENNIFER S. BISK,
Administrative Patent Judges.

BISK, *Administrative Patent Judge.*

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-31, 63, and 107-109. Claims 32-62 and 64-106 have been canceled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to an "electronic book selection and delivery system for distributing books and other textual information and for cataloging and searching the electronic books." Abstract.

Claim 1, reproduced below with emphasis added, is illustrative of the claimed subject matter:

1. A system for transmitting and receiving text, and displaying an indication of the text, wherein the text is transmitted in an electronic signal, the system comprising:

a processor that produces an electronic signal containing a representation of textual data corresponding to one or more electronic books;

a transmitter, connected to the processor, that transmits the electronic signal; and

a home subsystem, wherein the home subsystem includes:

a connector that receives the electronic signal;

means, connected to the connector, for selecting a portion of the textual data, comprising means for receiving a subscriber entry indicating a title of an electronic book, wherein the title correlates to a portion of the textual data;

an electronic collection of electronic books, ordered and transmitted electronically via the transmitter, wherein in response to a transmitted order, the ordered electronic book is transmitted from a remote operations center to the home subsystem and stored in a library unit of the home subsystem until a selection is received to view the electronic book;

means for associating subscriber-created data with individual electronic books located in the collection of electronic books;

means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books in a header file for each of the individual electronic books;

means for receiving one of a subscriber-entered selection and a subscriber-defined selection;

a menu generator that determines and generates a particular library menu of the books located in the collection based on at least one of the received selection and a default menu and generates a searchable menu of the electronic books in the electronic books collection;

means for selecting search criteria for the searchable menu based on at least one of the subscriber-entered selection and the subscriber-defined selection; and

a display, connected to the connector, that displays the particular library menu of books relating to the determination of the menu generator, and displays the subscriber-created data associated with each of the books included in the particular library menu.

THE REJECTIONS

Claims 1-13, 18-29, 63, and 107-109 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimune (US 6,438,233 B1; Aug. 20, 2002 (filed Aug. 4, 1997)) and Cassorla (US 5,146,552; Sept. 8, 1992).

Claims 14-17, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshimune, Cassorla, and Kubota (US 5,506,902; Apr. 9, 1996).

THE CONTENTIONS

The Examiner finds that Yoshimune discloses every limitation of claim 1 except “means for storing the subscriber-created data associated with individual electronic books located in the collection of electronic books

in a header file for each of the individual electronic books” (hereinafter the “storing limitation”). Ans. 7. The Examiner cites Cassorla as teaching this limitation. Ans. 7 (citing Cassorla, col. 5 ll. 31-50).

Appellants argue that none of the cited references teach the storing limitation. Br. 11-12.

ISSUE

Under § 103, has the Examiner erred in rejecting representative claim 1 by finding that Yoshimune and Cassorla collectively would have taught or suggested the storing limitation?

ANALYSIS

Based on the record before us, we find no error in the Examiner’s obviousness rejection of representative claim 1. Appellants assert that Cassorla discloses “adding header information to each of the reader-created annotations or storing the information of annotation locations in the control header.” Br. 11 (emphasis in original). According to Appellants, this is “in contrast to the claimed invention which recites storing ‘the subscriber-created data in a header file for each of the individual electronic books.’”¹ *Id.*

¹ The Examiner asserts that the storing limitation of claim 1 does not dictate the storage location of the subscriber-created data because it is “unclear if the limitations ‘**for each of the individual electronic books**’ refers back to ‘**a header file**’ or ‘**the subscriber-created data**.’” Ans. 14 (emphasis in original). Because we affirm the Examiner’s rejection as discussed *infra*, we need not and do not reach consideration of this interpretation. However, we The footnote is continued on the next page.

However, we find reasonable the Examiner's finding that including the location information in the header of an individual book file, as Appellants concede is taught by Cassorla (Br. 11), meets the storing requirement. Ans. 15 (“[A] reference pointer to the annotation file is still a representation of subscriber-created data stored in the header file of the electronic book file.”).

Appellants do not point to any explicit definition of “storing” in the Specification requiring that the “subscriber-created data associated with individual electronic books” be stored in any particular data format within the “header file for each of the individual electronic books.” Br. 10-12. Thus, we agree with the Examiner's broad construction of this term. Ans. 15. Accordingly, a person of ordinary skill in the art at the time of the invention would understand that the required storing limitation could be implemented using a pointer, a common technique for flexibly allocating memory by storing a memory location of some data rather than the data itself.² We therefore, do not find persuasive Appellants' argument that Cassorla does not disclose the storing limitation.

For these reasons, we sustain the Examiner's rejection of representative claim 1 and of claims 2-13, 18-29, 63, and 107-109, which were not argued separately.

point out that even if independent claims 1, 18, and 63 may be construed in this manner, independent claims 107, 108, and 109 have different wording for a similar storing limitation that appears to avoid this potential ambiguity.

² Pointer: “a data item consisting of an address that tells where to find a desired item.” DICTIONARY OF COMPUTER AND INTERNET TERMS 360 (6th ed. 1998).

In arguing the patentability of claims 14-17, 30, and 31, Appellants assert that Kubota does not cure the alleged deficiencies in Yoshimune and Cassorla as argued with respect to claim 1. Br. 9. As we are not persuaded that the Examiner erred in rejecting claim 1, we are similarly not persuaded that the Examiner erred in rejecting claims 14-17, 30, and 31. Accordingly, we also sustain the rejection of claims 14-17, 30, and 31.

DECISION

The Examiner's decision to reject claims 1-31, 63, and 107-109 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw